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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,266	03/12/2004	Julian R. Rogers JR.	BWT3003-0032	5862

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CERMAK & KENEALY, LLP
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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,266	ROGERS, JULIAN R.	
	Examiner	Art Unit	
	Jila M. Mohandesi	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 19-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03-12-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 19-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/25/06.
2. Applicant's election with traverse of invention I, claims 1-18 in the reply filed on 08/25/06 is acknowledged. The traversal is on the ground(s) that should a generic claim be allowed and/or should the method claims be amended to include the features of an allowable product claim it will allow for rejoinder of the claims. This is not found persuasive because there is no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "the equipment" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Frey et al. (US patent no. 4,801,213). Frey '213 discloses an equipment shipping device (10), comprising: an inflatable bladder that is configured to fit within a standard case; a plurality of baffles located at predetermined locations in the bladder such that when the bladder is inflated, the shipping device takes the form of the standard case's interior volume when placed therein; and a valve (50) located adjacent the inflatable bladder. See figure 1 embodiment.

The equipment shipping device of Frey '213 is capable of enclosing flexible endoscope equipment.

7. Claims 1-3 and 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka (US patent no. 6,629,777). Tanaka '777 discloses an equipment shipping device, comprising: an inflatable bladder in the form of a pouch that is configured to fit within a standard case; a plurality of baffles located at predetermined locations in the bladder such that when the bladder is inflated, the shipping device takes the form of the standard case's interior volume when placed therein; and a valve located adjacent the inflatable bladder. See figures 1-16 embodiments.

The equipment shipping device of Tanaka '777 is capable of enclosing flexible endoscope equipment.

8. Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickinson (US publication 2003/0052035). Dickinson discloses an equipment shipping kit, comprising: a pouch formed by at least one inflatable bladder (80) including, a plurality of baffles, and a valve located adjacent to the inflatable bladder; and a primary pouch (casing 15) including an open end having a seal. See Figure 4 embodiment.

The equipment shipping device of Dickinson is capable of enclosing flexible endoscope equipment.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 10-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher (US patent 4,917,238) in view of Dickinson. Schumacher '238

discloses an equipment shipping kit, comprising: a first pouch (53); a primary pouch (pouch 60 with press locked end 61) including an open end having a seal and a secondary/return pouch (54) including an open end having a seal; and a plurality of caps (65, 68) configured to be placed over portions of the equipment to protect the pouch during shipment of the equipment. Schumacher '238 does not appear to disclose the pouches to be formed by at least one inflatable bladder including, a plurality of baffles, and a valve located adjacent to the inflatable bladder. Dickinson discloses that it is desirable to make pouches formed by at least one inflatable bladder (80) including, a plurality of baffles, and a valve located adjacent to the inflatable bladder to better protect articles held therein. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the pouches of Schumacher '238 from at least one inflatable bladder (80) including, a plurality of baffles, and a valve located adjacent to the inflatable bladder as taught by Dickinson to better protect the articles held therein.

With respect to the size and thickness of the pouches, it would have been an obvious matter of design choice to modify the size and thickness of the pouches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to claims 14 and 15, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

12. Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher (US patent 4,917,238) in view of Tanaka et al. (US patent no. 6,629,777). Schumacher '238 discloses an equipment shipping kit, comprising: a first pouch (53); a primary pouch (pouch 60 with press locked end 61) including an open end having a seal and a secondary/return pouch (54) including an open end having a seal; and a plurality of caps (65, 68) configured to be placed over portions of the equipment to protect the pouch during shipment of the equipment. Schumacher '238 does not appear to disclose the pouches to be formed by at least one inflatable bladder (80) including, a plurality of baffles, and a valve located adjacent to the inflatable bladder. Tanaka'777 discloses that it is desirable to make pouches formed by at least one inflatable bladder (80) including, a plurality of baffles, and a valve located adjacent to the inflatable bladder to better protect articles held therein. The pouch includes an adherence portion located at one end of the top portion and the bottom portion such that the pouch is folded along a hinge, the top portion and bottom portion can be adhered to each other to form a containment area between the top portion and bottom portion. See Figures 1-16 embodiments. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the pouches of Schumacher '238 from at least one inflatable bladder (80) including, a plurality of baffles, and a valve located adjacent to the inflatable bladder as taught by Tanaka '777 to better protect the articles held therein.

With respect to the size and thickness of the pouches, it would have been an obvious matter of design choice to modify the size and thickness of the pouches, since

such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to claims 14 and 15, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

13. Claims 4-5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka '777. With respect to the size and thickness of the pouches, it would have been an obvious matter of design choice to modify the size and thickness of the pouches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion

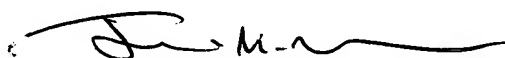
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are inflatable bladders analogous to applicant's instant invention.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
October 19, 2006